

Appln. No. 09/687,759  
Amendment dated July 1, 2005  
Reply to Office Action mailed March 3, 2005

### AMENDMENTS TO THE DRAWINGS:

The attached replacement sheets of drawings include corrections to Figures 1 through 7, 10 through 22, and 26. The attached annotated sheets show these corrections in red.

In Figures 1 and 13-22, type written designations for FIG. 1 and FIGS. 13-22 have been added to replace the hand written designations in the originally filed drawings.

Originally filed Figures 2 through 7, 10 through 12 and 26, each had unlabelled sheets. The changes to these figures add labels for each of these sheets. In particular, Figure 2 has been amended to label each sheet using the designations, respectively: Figs. 2A, 2B, and 2C. Figure 3 has been amended to use the designations Figs. 3A, 3B, 3C. Figure 4 has been amended to use the designations Figs. 4A, 4B, 4C. Figure 5 has been amended to use the designations Figs. 5A, 5B, 5C. Figure 6 has been amended to use the designations Figs. 6A, 6B, 6C. Figure 7 has been amended to use the designations Figs. 7A, 7B. Figure 10 has been amended to use the designations Figs. 10A, 10B, 10C, 10D, 10E, 10F. Figure 11 has been amended to use the designations Figs. 11A, 11B, 11C, 11D, 11E, 11F. Figure 12 has been amended to use the designations Figs. 12A, 12B, 12C, 12D, 12E, 12F. Figure 26 has been amended to Figs. 26A, 26B.

Attachment: Replacement Sheets (48 replacement sheets)  
Annotated Sheets Showing Changes in Red (48 annotated sheets)

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### REMARKS

Reconsideration of the subject application is respectfully requested.

Claims 1-110 are pending in the subject application.

The Examiner has rejected claims 1-108<sup>1</sup> under 35 U.S.C. 112, second paragraph. In particular, the Examiner has taken the position that "[t]aken as a whole the claims recite an undue multiplicity of claims by virtue of the unreasonable number of claims presented would tend to obfuscate, confuse, and becloud the claimed invention." (Official Action, p. 2, also citing M.P.E.P. 2173.05(n).) The Examiner has required that Applicant select certain claims, not to exceed twenty-five, for examination on the merits, and cancel the non-selected claims or present arguments as to why the rejection is in error. The Examiner has also noted that "it would appear that a multiplicity of inventions also appear to be involved" and requested that Applicant group the "selection accordingly to read on a single invention," and that applicant should group the claims according to what are believed to be distinct inventions, which may be restricted in a subsequent action. (*Id.*)

As set forth below, Applicants respectfully traverse the Examiner's rejection.

#### Selection of Claims

Notwithstanding Applicants' traverse of the Examiner's rejection, Applicants hereby select claims 1-25 for examination on the merits, as required by the Examiner.

#### The Examiner's Rejection

Applicants respectfully submit that the claims filed with the subject application are not excessive in number, and would not tend to obfuscate, confuse, and becloud the claimed invention. First of all, the submitted claims are intended to secure for Applicants the scope and breadth of protection to which Applicants are entitled under the law. For example, as permitted by 35 U.S.C. 112, paragraph 3, Applicants have

<sup>1</sup> It is believed that "108" is a typographical error, and that the Examiner had intended to include in his rejection all 110 claims that were filed in the original application.

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submitted claims in both independent and dependent form. Further, Applicants have submitted claims in both method and apparatus formats. (MPEP 806.05(e).)

Second, Applicants respectfully submit that the claims are not duplicative in that each claim employs different words and phrases, and are directed to different embodiments of the invention in order to provide a variety of claims of varying scope. For example, as set forth in the table below, the claims are directed to different embodiments of the invention, including method and apparatus embodiments, embodiments providing a cut grade relating to fire using a metric, embodiments providing a cut grade relating to fire and cut proportions, embodiments providing grading reports, and embodiments relating to cutting a diamond.

Third, having a variety of claims of varying scope is particularly important in light of the recent trend in the case law toward restricting the availability of the Doctrine of Equivalents, as represented by the U.S. Supreme Court's decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 62 USPQ2d 1705 (2002), and the Federal Circuit's decisions in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 68 USPQ2d 1321 (Fed. Cir. 2003) (*en banc*), and *Honeywell International Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 71 USPQ2d 1065 (Fed. Cir. 2004) (*en banc*) (rewriting a dependent claim into independent form gives rise to a presumptive surrender of equivalents).

Fourth, although the Examiner has relied upon a statistic from the Federal Register: October 5, 1998 (Volume 63, Number 192, Page 53507) to support his assertion that twenty-five (25) claims is a reasonable number, it is noted that the Patent and Trademark Office took up the question of whether there should be a limitation on number of claims, but decided not to adopt such a limitation. See "Notice of proposed rulemaking," *Changes to Implement the Patent Business Goals*, 1228 Off. Gaz. Pat. Office 15 (November 2, 1999) (notice does not propose changing 1.75 to place a limit on the number of claims examined in a single application). In this regard, having paid the required fees for all claims pending in the subject application, it is respectfully submitted that Applicants are entitled to examination of all such claims.

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Grouping of claims:

In the following table, as requested by the Examiner, Applicants have provided a grouping of claims: four of the groups have method claims, and the other four groups have apparatus claims. As indicated above, these groups relate to different embodiments of the invention.

| GROUP | DESCRIPTION  | CLAIMS         |
|-------|--|----------------|
| I     | Method: Cut grade for a gemstone relating to fire using a metric.            | 1-25           |
| II    | Method: Grading reports relating to dispersed color light return or fire.    | 26, 27, 38-53  |
| III   | Method: Diamond cutting relating to dispersed color light return.            | 28, 29         |
| IV    | Method: Cut grade for a gemstone relating to fire and cut proportions.       | 30-37          |
| V     | Apparatus: Cut grade for a gemstone relating to fire using a metric.         | 54-78          |
| VI    | Apparatus: Grading reports relating to dispersed color light return or fire. | 79, 80, 91-110 |
| VII   | Apparatus: Diamond cutting relating to dispersed color light return.         | 81, 82         |
| VIII  | Apparatus: Cut grade for a gemstone relating to fire and cut proportions.    | 83-90          |

Corrected Drawings:

Responsive to the Examiner's objection to the drawings, corrected drawings are submitted under separate cover herewith.

Amendments to the Specification:

The amendments to the specification were made to reflect the corrected figure designations as set forth above.

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Conclusion:

It is respectfully submitted, in view of the foregoing, that the subject application is in condition for examination, and the Examiner's timely examination thereof is respectfully requested.

Respectfully submitted,  
DLA Piper Rudnick Gray Cary US LLP

Dated: July 1, 2005

By: 

Andrew V. Smith  
Reg. No. 43,132  
Tel.: (415) 836-2500

Attn. Patent Department  
DLA Piper Rudnick Gray Cary US LLP  
153 Townsend Street, Suite 800  
San Francisco, CA 94107-1922

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